



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,843	09/17/2003	Shigekazu Zen	Q77444	2852
23373	7590	02/23/2005	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			PAK, JOHN D	
			ART UNIT	PAPER NUMBER
			1616	

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/663,843	Applicant(s) ZEN, SHIGEKAZU	
	Examiner JOHN PAK	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 08/961,272.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

Art Unit: 1616

This Office is in reply to applicant's amendments and remarks of 11/24/2004.

Claims 1, 4-10 are pending in this application.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmitt et al. (US 5,389,300) in view of Derwent abstracts 1993-206225 and 1978-57608A.

Schmitt et al. disclose formulations for protecting sawn timber against fungi and insects (column 1, lines 4-6; column 3, lines 27-32). In addition to o-phenylphenol and iodopropargyl derivatives as active ingredients, pyrethroids are disclosed to be used together to increase the spectrum of action or achieve specific effects (column 4, lines 38-45). Specifically disclosed pyrethroids include cyhalothrin, cypermethrin, permethrin and deltamethrin (id.). The pyrethroids can be used at a concentration range of 0.001 to 10 wt% (column 4, lines 51-53). The formulation is prepared by dissolving the active compounds in a solvent, with auxiliaries such as emulsifiers (column 2, lines 61-66). Butyl benzoate is specifically disclosed as a suitable solvent (column 3, lines 9-12). Suitable emulsifiers include nonionic and anionic surface active agents (column 3, lines

17-26). Solvent amount in the concentrate formulation is at least 20 wt% (column 4, line 54; column 5, lines 8-25). Surfactant concentration is about 5-25 wt% (see claim 3 and column 5, lines 4-25). Concentrated emulsions are disclosed (column 2, lines 41-44).

Derwent abstract 1993-206225 is cited to establish that cypermethrin and permethrin are known to be used to protect wood against termites. Derwent abstract 1978-57608A is cited to establish that permethrin is known to be used to protect wood against termites.

The difference between the claimed invention and the primary reference by Schmitt et al. that the reference does not explicitly include a pyrethroid in any specific example. However, one having ordinary skill in the art would have been motivated to further protect Schmitt's sawn timber by including an insecticide such as cypermethrin or permethrin, because those pyrethroids are well known in the art to protect wood against the wood destroying termites.

Applicant's formulation, "pesticidal emulsifiable concentrate" is amply disclosed and suggested by Schmitt et al. The definition of pesticidal emulsifiable concentrate is given by applicant as "normally composed of a pesticidal active ingredient compound, a surfactant and an organic solvent." (specification page 1, lines 11-13). Schmitt et al. clearly disclose such a formulation type in that the corresponding ingredients are all disclosed in claim-recited concentration amounts, wherein concentrated emulsions are

Art Unit: 1616

disclosed. Use of the organic solvent butyl benzoate is preferred (column 3, lines 11-12), so selection of the same would have been fairly suggested.

Therefore, the claimed invention, as a whole, would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention and the claimed invention as a whole have been fairly disclosed or suggested by the combined teachings of the cited references.

To date, no objective evidence of nonobviousness has been provided with respect to the amended subject matter that remains in the claims, i.e. formulations wherein the aromatic ester is represented by formula [1].

Therefore, the claims must be rejected as set forth above.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 1616

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the Examiner should be directed to JOHN PAK whose telephone number is **(571)272-0620**. The Examiner can normally be reached on Monday to Friday from 8 AM to 4:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's SPE, Gary Kunz, can be reached on **(571)272-0887**.

The fax phone number for the organization where this application or proceeding is assigned is **(571)273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JOHN PAK
PRIMARY EXAMINER
GROUP 1600